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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/903,743	07/31/1997	TIMOTHY MERRICK LONG	169.0568	2593

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EXAMINER
PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	08/903,743	LONG ET AL.
	Examiner	Art Unit	
	CESAR B. PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _12/27/05_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1, 3-4, 7, 9-12, 27-29, 31-33, 38, and 42-57_ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,3,4,7,9-12, 27-29, 31-33,38 and 42-57_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _11 May 2004_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the amendment filed on 12/27/2004.

This action is made Final.

2.   In the amendment, claim 57 has been added. Claims 1, 3-4, 7, 9-12, 27-29, 31-33, 38, and

42-57 are pending in the case. Claims 1, 27-29, 31, 38, and 54-57 are independent claims.

Drawings

3.   The drawings filed on 5/11/2004 have been accepted by the Examiner.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 1, 3-4, 7, 9-12, 22, 27-29, 31, 38, 42-56 remain, and 57 is rejected under 35

U.S.C. 103(a) as being unpatentable over Nehab et al, hereinafter Nehab (Pat. # 6,029,182,

2/22/00, filed on 10/4/96), in view of Savitzky et al, hereinafter Savitzky (Pat. # 6,012,083,

1/4/2000, filed on 9/24/1996).

Regarding independent claim 1, Nehab teaches the creation of a personalized document.

This document is created by collating and arranging various stand alone web pages of different

newspapers articles into a single linear or continuous printable document. A "site driver" is used

for monitoring web page sections accessed, and url addresses or commands—*access patterns* of

websites accessed by the user-- entered by a user into a profile editor-- *second application*--

while navigating a network web pages—*accessing plurality of hyper-text documents and

formatting information*. The driver records the web sites accessed in a log, as urls or as rules, for

the later retrieval, and formatting these documents into a single linear document of documents

similar to those accessed by the user (c.3, L.15-c.4,L.67, c. 8,L.34-67, c.7,L.57-67, fig.1,4).

Nehab fails to explicitly disclose: *monitoring a second application operating independently of

said first application on said local machine, to identify the plurality of hyper-text documents

accessed independently by the second application.* However, Savitzky teaches an independent

agent for providing a history of all the documents accessed by a client (col.3, lines 45-67, abst.,

fig.1). It would have been obvious to a person of ordinary skill in the art at the time of the

invention to have combined Nehab, and Savitzky, and have monitored the second application--

client, because Savitzky teaches providing agents that are independent of the client and server

(col. 3, lines 1-26, col.4, lines 16-32). This provides the benefit of providing an agent that is

flexible, and does not depend or is tied down to either the client or server.

Moreover, Nehab teaches the recording of selected hyperlinks portions or articles of

webpages into a log using the articles' address or format information (c.3, L.15-c.4,L.67,

c.8,L.34-67).

Furthermore, Nehab teaches the retrieving, and formatting of the various web pages using

the address/location—*formatting information*, and/or articles of different newspapers into a

single printable document, where the various newspapers are contiguously laid out (c.3, L.15-

c.4,L.67, c.9,L.40-63).

Regarding claim 3, which depends on claim 1, Nehab teaches the creation, by a stand

alone *first application*, of a personalized document by collating and arranging various web pages

of different newspapers articles into a single linear or continuous printable document (c.3, L.15-

c.4,L.67, c.9,L.40-62). Nehab fails to explicitly disclose: ....*the printable document is updated*

upon new hyper-text pages being accessed by the second application. However, it would have

been obvious to a person of ordinary skill in the art at the time of the invention to have updated

the document, because Nehab teaches the duplication of user's selection criteria in clicking on

hyperlinks in a web site (col. 8, lines 34-67). This provides the benefit of automatically, and

interactively reproducing user's selection of hyperlinks, while avoiding time consuming manual

update of the document.

Regarding claim 4, which depends on claim 1, Nehab teaches a tracking program for the

monitoring of url addresses or commands entered by a user while navigating a network web

pages (c. 8,L.34-67)-- ....*said steps are performed in a background mode relative to the user's*

access to the hyper-text documents.

Regarding claim 7, which depends on claim 1, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers into a single printable document of multiple columns (c.14, L.47, and c.16,L.1-67).

Regarding claim 9, which depends on claim 1, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers into a single printable document with an index, and table of contents of the links to articles source links in the web pages (c.14, L.47-67, and c.15,L.20-c.16,L.67)--....*the printable document comprises a table of contents listing each hyper-text document ....*

Regarding claim 10, which depends on claim 1, Nehab discloses formatting different newspaper articles into a single printable document with hyperlink references to the articles' sources --....*hyper-link index of at least one hyper link reference ...* (c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Regarding claim 11, which depends on claim 10, Nehab discloses formatting different newspaper articles into a single printable document with hyperlink cross-references to an index --.... *each hyper-link reference in the printable document is tagged with a cross reference to a corresponding entry ...* (c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Regarding claim 12, which depends on claim 10, Nehab discloses including all hyperlink references of each article represented in the formatted document .... *said hyper-link index*

comprises all hyper-link references of each hyper-text ....--(c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Claim 22 is directed towards a method for carrying out the steps found in claim 12, and therefore is similarly rejected.

Regarding independent claim 27, Nehab teaches the creation, by a stand alone *first application in a local computer*, of a personalized document by collating and arranging various web pages, from websites--*sources*, of different newspapers articles into a single linear or continuous printable document according to the size of the respective articles (c.3, L.15-c.4,L.67, c.13,L.12-67, fig. 1, 4, 9A). Nehab fails to explicitly disclose: *monitoring accesses by the second application to the plurality of documents in sequence.* However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have monitored the second application--browser, because Nehab teaches the duplication of user's selection criteria in clicking on hyperlinks in a web site (col. 8, lines 34-67). This provides the benefit of automatically, and interactively monitoring user's selection of hyperlinks, while interacting with only one application—the browser—instead of manually interacting with both the browser and the web reader to input user's browsing preferences.

Moreover, Nehab teaches the recording of selected hyperlinks of portions or articles of webpages into a log using the articles' address or format information (c.3, L.15-c.4,L.67, c.8,L.34-67).

Furthermore, Nehab teaches the retrieving, and formatting of the various web pages according the address/location—*formatting information*, and/or articles of different newspapers—*size information*-- into a single printable document, where the various newspapers are contiguously laid out (c.3, L.15-c.4,L.67, c.9,L.40-63).

Claim 28 is directed towards a computer system for carrying out the steps found in claim 27, and is similarly rejected.

Claim 29 is directed towards a computer readable medium for storing the steps found in claim 1, except for the retrieval of documents from a network, which is taught by Nehab (col.8, lines 33-67, fig.4), and is similarly rejected.

Claim 31 is directed towards a computer program product having a computer readable medium, and a browser for storing, and implementing the steps found in claim 1, and is similarly rejected.

Claim 38 is directed towards a method for forming a single printable documents for carrying out the steps found in claim 27, except for the access patterns (which is taught by Nehab as indicated in the rejection of claim 1) and is similarly rejected.

Claims 42-45 are directed towards a method for forming a single printable documents for carrying out the steps found in claim 1, and therefore are similarly rejected

Claims 46-47 are directed towards a computer program product having a computer

readable medium for storing the steps found in claim 1, and therefore are similarly rejected.

Regarding independent claim 48, Nehab teaches the creation, by a stand alone *first*

application in a local computer, of a personalized document. This document is created by

collating and arranging various stand alone web pages of different newspapers articles into a

single linear or continuous printable document. A "site driver" is used for monitoring web page

sections accessed, and url addresses or commands—*access patterns* of websites accessed by the

user-- entered by a user into a profile editor-- *second application*-- while navigating a network

web pages—*accessing plurality of hyper-text documents and formatting information*. The driver

records the web site accessed in a log, as urls or as rules, for the later retrieval, and formatting

into a single linear document of documents similar to those accessed by the user (c.3, L.15-

c.4,L.67, c. 8,L.34-67, c.7,L.57-67, c.9,L.62-c.10,L.21, fig.1,4). Nehab fails to explicitly

disclose: *displaying the list of the plurality of documents*. However, it would have been obvious

to a person of ordinary skill in the art at the time of the invention to have displayed the list of

documents, because this would have enabled the user to edit the list of documents according to

user's preferences, and taste, as suggested above.

Moreover, Nehab fails to explicitly disclose: *fetching independently of the second*

application each document selected from the list and formatting. However, Savitzky teaches an

independent agent for providing a history of all the document accessed by a client (col.3, lines

45-67, abst., fig.1). It would have been obvious to a person of ordinary skill in the art at the time

of the invention to have combined Nehab, and Savitzky, and have monitored the second

application--client, because Savitzky teaches avoiding providing agents that are independent of the client and server (col. 3, lines 1-26, col.4, lines 16-32). This provides the benefit of providing a agent that is flexible, and does not depend or is tied down to either the client or server.

Furthermore, Nehab teaches the a graphical user interface for editing the document list or profile, and formatting of the various web pages according to user's dictates (c.9, L.35-67).

Claim 49 is directed towards a method for forming a single printable documents for carrying out the steps found in claim 48, and is similarly rejected. ..

Regarding claim 50, which depends on claim 48, Nehab teaches the creation of a personalized document by retrieving, collating--*compiling*-- and arranging various web pages of different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.10,L.21-44).

Claims 51-53 are directed towards a computer program product having a computer readable medium for storing the steps found in claims 48-50, and therefore are similarly rejected.

Claim 54 is directed towards a method for forming the print list for found in claim 1, and is similarly rejected.

Claim 55 is directed towards an apparatus for carrying out the steps found in claim 1, and is similarly rejected.

Claim 56 is directed towards a computer program product having a computer readable

medium for storing the steps found in claim 1, and is similarly rejected.

Claim 57 is directed towards a computer apparatus for carrying out the program found in

claim 48, and is similarly rejected.

6.   Claims 32-33 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab,

in view of Savitzky, and further in view of Hayashi et al (Pat. # 5,633,996, 5/27/97, filed on

11/8/94).

Regarding claim 32, which depends on claim 7, Nehab teaches the creation of a

personalized document by collating and arranging various web pages of different newspapers

into a single printable document (c.3, L.15-c.4,L.67). Nehab fails to explicitly disclose:

....*maximizing the number of hyper-text documents on each page*...... However, Hayashi et al

disclose: "....searching an area for display or printing to which the contents of the document can

be laid out......" (Col. 3, lines 7-24). It would have been obvious to a person of ordinary skill in

the art at the time of the invention to had combined the teachings of Nehab, Savitzky, and

Hayashi et al, because Hayashi et al teach above search of printable or displayable space the

automatic layout of a structured document into a multicolumn document.

Regarding claim 33, which depends on claim 32, Nehab teaches the creation of a

personalized document by collating and arranging various web pages of different newspapers

into a single printable document (c.3, L.15-c.4,L.67). Nehab fails to explicitly disclose:

....*determining if space exists on a page of the printable document.....if so, inserting the*

formatted hyper-text document...... However, Hayashi et al disclose: "....searching an area for

display or printing to which the contents of the document can be laid out......" (Col. 3, lines 7-

24). It would have been obvious to a person of ordinary skill in the art at the time of the

invention to had combined the teachings of Nehab, Savitzky, and Hayashi et al, because Hayashi

et al teach above search of printable or displayable space the automatic layout of a structured

document into a multicolumn document.

Response to Arguments

7.   Applicant's arguments filed 12/27/2004 have been fully considered but they are not

persuasive. Applicants note neither Nehab nor Savitzky teach a first application found in a local

machine, for forming a single continuous printable document by collating a plurality of hypertext

documents, and the monitoring of access patterns of a second application which operates

independently of said first application on said local machine (pages 18-19). The Examiner

disagrees, because Nehab teaches the creation of a personalized document. This document is

created by collating and arranging various stand alone web pages of different newspapers articles

into a single linear or continuous printable document. A "site driver", *in a client computer*

(fig.1,4), is used for monitoring web page sections accessed, and url addresses or commands—

access patterns of websites accessed by the user-- entered by a user into a profile editor-- *second*

application-- while navigating a network web pages—*accessing plurality of hyper-text*

documents and formatting information. The driver records the web site accessed in a log, as urls

or as rules, for the later retrieval, and formatting into a single linear document of documents

similar to those accessed by the user (c.3, L.15-c.4,L.67, c. 8,L.34-67, c.7,L.57-67). Nehab fails

to explicitly disclose: *monitoring a second application operating independently of said first*

application on said local machine, to identify the plurality of hyper-text documents accessed

independently by the second application. However, Savitzky teaches an independent agent for

providing a history of all the documents accessed by a client (col.3, lines 45-67, abst., fig.1). It

would have been obvious to a person of ordinary skill in the art at the time of the invention to

have combined Nehab, and Savitzky, and have monitored the second application--client, because

Savitzky teaches providing agents that are independent of the client and server (col. 3, lines 1-26,

col.4, lines 16-32). This provides the benefit of providing an agent that is flexible, and does not

depend or is tied down to either the client or server.

Regarding claim 1, the Applicants indicate that Savitsky's agent is dependent upon

appropriate handling of requests deliveries via the agency application (page 21). The Applicants

are deriving this conclusion from a figure built based upon Applicants understanding of Savitsky.

However, this does not reflect the teachings of Savitsky as applied in the rejections, because the

agent of Savitsky is independent and separate from a client browser, and compiles a list of

documents accessed by a client user (col.3, lines 45-53). In other words, the client browser

decides what documents it is accessing without any control, or independently from the agent (as

recited in claim 1, parag.2). The agent simply records the action of the client.

In response to applicant's argument that the combination of Nehab, and Savitsky as

understood by applicant and shown in fig.F, would require operation of the browser dependent

upon the operation of the agency (page 22, parag. 2-3), the fact that applicant has recognized

another advantage which would flow naturally from following the suggestion of the prior art

cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex*

parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Moreover, Applicants note that the combination of Nehab and Savitsky would create a

duplicate log file, which would then be provided to the personal profile again for subsequent

retrieval (page 23, parag.1). The Examiner disagrees, because the combination of the creation of

the log by a "site driver" included (dependent on) in the "profile editor" browser, taught by

Nehab (col.8, lines 33-50, fig. 4), with the decoupled agent for logging sites accessed by a client

(same thing done by Nehab profile editor) browser as taught by Savitsky (col.3, lines 45-57),

would yield an independent and decoupled agent for creating the log.

In addition, Applicants argues that since all browser requests are made through the

agency, there is a dependence of operation (page23, parag. 2). The Examiner would agree that

there is some dependence in the combination, as there is in Applicants invention (the monitoring

agent depends on the browser commands, in order to perform the monitoring. The agent can only

reflect what's taking place in the browser). Having said this, the Examiner would also like to

point out that there is an independence relationship between the agent, and the browser as

applied in the rejection. <u>The browser navigates independently from the agent. The agent doesn't</u>

<u>know or control where the browser is going to go next.</u>

Further, Applicants indicate that the agent of Savitsky <u>may be</u> implemented in a computer

different from the web client, contrary to what's recited in claim 1 (page 23, parag.3). This is

only one of several embodiments, the embodiment relied upon here is one where the agent is

operating in the same computer as the browser is.

Claims 27-29, 31, 38, 42, 46, 48, 51, and 54-57, are directed to various methods, systems,

etc., similar to claim 1, and therefore the response above likewise apply to them.

Should Applicants need to further discuss the rejection included above, please contact the

Examiner (the phone number is listed below) to schedule an interview.

Conclusion

8.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).
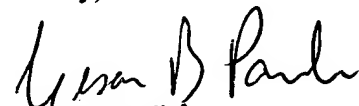
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Any response to this Action should be mailed to:

> Commissioner for Patents
> P.O. Box 1450
> Alexandria, VA 22313-1450

Or faxed to:

- **(703) 703-872-9306,** (for **all** Formal communications intended for entry)

CESAR PAULA
PRIMARY EXAMINER
4/15/05